

Attorney Docket No.: P-US-TN-3305

Application Serial No.: 10/688,668

REMARKS

The Office Action dated November 6, 2009, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 1 has been amended and claims 4 and 82 have been canceled. New claim 85 has been added. No new matter is presented. Support for the amendment to claim 1, can be found in at least paragraph [0052] of the specification as originally filed. Claims 1-3, 5, 66-69, 71 and 80, 81 and 83-85 are pending and respectfully submitted for consideration.

Claim Objections

Claim 4 was objected to for a minor informality. Responsive to the objection, the Applicants have canceled claim 4. Accordingly, the Applicants respectfully request withdrawal of the objection.

Rejections Under 35 U.S.C. § 103**Claims 1-4**

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao (U.S. Patent No. 6,263,866) in view of Greenland (U.S. Patent No. 6,276,990, "Greenland '990"). As noted above, claim 4 has been canceled. Claims 2 and 3 depend from claim 1.

Tsao was cited for disclosing many of the claimed elements of the invention with the exception of a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis. Greenland '990 was cited for curing this deficiency. The Applicants traverse the rejection and respectfully submit that claims 1-3 recite subject matter that is neither disclosed nor suggested by the cited references.

Claim 1, as amended, recites one of the frame assembly and the support assembly has a first post, and the other of the frame assembly and the support assembly has a first hole for receiving the first post; and one of the frame assembly and the support assembly has a second post, and the other of the frame assembly and the support assembly has a second hole for receiving the second post. In contrast, Tsao and Greenland '990 either singly or in combination

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do not disclose or suggest this feature. As such, the combination of the Tsao and Greenland '990 fails to disclose or suggest the features of the invention as recited in claim 1 and therefore, dependent claims 2 and 3.

Claim 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Greenland '990 in view of Fuhrman et al. (U.S. Patent No. 6,637,424, "Fuhrman"). As a preliminary matter, the Applicants note that claim 5 depends from claim 1. However, the rejection of claim 5 does not appear to include the Tsao reference. Nevertheless, the Applicants respectfully submit that Fuhrman fails to cure the deficiencies in Tsao and Greenland '990 with respect to claim 1 and therefore, dependent claim 5, as Fuhrman also does not disclose or suggest at least the claimed arrangement of the first post and second post.

Claims 66-68, 80 and 82-84

Claims 66-68, 80 and 82-84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao (U.S. Patent No. 6,263,866) in view of Greenland '990". As noted above, claim 82 has been canceled. Claims 68 and 84 depend from claim 67, claim 80 depends from claim 1 and claim 83 depends from claim 66. Tsao was cited for disclosing many of the claimed elements of the invention with the exception of:

the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, and a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary, wherein the support assembly comprises a generally U-shaped member having first and second legs with the switch disposed on the U-shaped member and the motor assembly pivotably supported by the first and second legs.

Greenland '990 was cited for curing these deficiencies. The Applicants traverse the rejection and respectfully submit that claims 66-68, 80, 81, 83 and 84 recite subject matter that is neither disclosed nor suggested by the cited references.

Claims 66 and 67 recite, in part, a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary. The Office Action acknowledged that "the modified

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device of Tsao still does not disclose that the location of the switch is such that the switch is disposed on the generally U-shaped member." See page 7 of the Office Action. The Office Action asserted that the indication from the prior art is that the location of the switch would have been an obvious matter of design choice. However, the prior art cited by the Office Action: Lee (U.S. Patent No. 6,272,961), Jameson (U.S. Patent No. 3,777,792), Weissman (U.S. Patent No. 4,885,956), Mayfield (U.S. Patent No. 5,063,806), Rueb (U.S. Patent No. 5,577,428), Welch (U.S. Patent No. 5,906,528), Greenland (U.S. Patent No. 6,080,041, "Greenland '041"), and Gorgol et al. (U.S. Patent No. 6,273,081), fail to cure the deficiencies in Tsao and Greenland '990 with respect to claims 66 and 67 for the following reasons.

In the modified device of Tsao (Tsao in combination with Greenland '990) the Office Action asserted that the supporting arm 16 was comparable to the claimed generally U-shaped member. However, the modified device of Tsao teaches away from a switch disposed on a generally U-shaped member. Specifically, Greenland '990 discloses a "drawback ...related to the manual switch that activates the motor. Because this switch must be activated by the operator again and again as each of the numerous tiles are cut, a particular job will take longer due to the cumulative time spent in activating and deactivating the switch for each tile cut." See column 1, lines 46-51 of Greenland '990. As such, Greenland teaches automatic activation of the power switch mounted to the motor assembly. See column 2, lines 32-44 of Greenland. Therefore, it would not have been obvious to one of ordinary skill in the art to locate the switch on the arm 16 or off of the motor because Greenland '990, of the modified device of Tsao, teaches that such an arrangement is unsatisfactory for automatic activation of the power switch by the workpiece. See column 2, lines 40-42 of Greenland '990.

Under U.S. patent practice, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See MPEP § 2143.01(v). In this case, the proposed modification of the modified device of Tsao would change the power switch and switching operation from the motor assembly to the support assembly (16 in Greenland '990) rendering the switch unsatisfactory for its intended purpose "to automatically turn on the motor as the tile is moved toward the motor assembly." See column 3, lines 25-28 of Greenland '990.

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Therefore, the combination of Tsao and Greenland '990 with Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol teaches away from disposing the power switch on the U-shaped member and therefore, fail to support a *prima facie* case of obviousness for purposes of a rejection of claims 66 and 67.

The Applicants further submit that none of Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol disclose or suggest even the feature of the switch disposed on a U-shaped member. Under U.S. patent practice, silence in a reference is not a proper substitute for adequate disclosure of facts from which a conclusion of obviousness may justifiably follow. See, e.g., In re Burt, 148 USPQ 548 (CCPA 1966). Therefore, without any adequate disclosure or suggestion that the switches in the cited references are on a U-shaped member, the cited references further fail to cure the deficiencies in the combination of Tsao and Greenland '990. As such, the combination of Tsao, Greenland '990 Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol do not teach or suggest the claimed features of the invention as recited in claims 66 and 67, and thereby fail to support a *prima facie* case of obviousness. As such, the Applicants respectfully submit that claims 66 and 67 are allowable.

As the cited references do not disclose or suggest the features of the invention as recited in claims 66 and 67, the references fail to teach or suggest the features of the invention as recited in dependent claims 68, 80, 81, 83 and 84.

Claims 69, 71 and 81

Claim 69 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao in view of Greenland '990, Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol and further in view of McCambridge et al. (U.S. Patent No. 4,350,193), Marcoux et al. (U.S. Patent No. 3,342,226), Brenta (U.S. Patent No. 4,105,055), Sanfilippo (U.S. Patent No. 6,745,803) and Otto U.S. Patent No. (U.S. Patent No. 5,161,590).

Claims 71 and 81 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao in view of Greenland '990, Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol and further in view of Sigetich et al. (U.S. Patent No. 4,428,159).

The Applicants traverse the rejections and respectfully submit that claims 69, 71 and 81 recite subject matter that is neither disclosed nor suggested by the cited references. Claim 69 depends from claim 67, claim 71 depends from claim 1, and claim 81 depends from claim 66.

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As discussed above, the combination of Tsao and Greenland '990 in combination with Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol fails to teach or suggest the features of the invention as recited in claims 1, 66 and 67. Fuhrman, McCambridge, Marcoux, Brenta, Sanfilippo, Otto and Sigetich further fail to cure the deficiencies in the above-cited references as they also do not disclose or suggest at least the features of the claimed first and second posts and a switch disposed on a generally U-shaped member. Accordingly, the Applicants respectfully submit that Tsao and Greenland '990 in combination with Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland '041, and Gorgol, Fuhrman, McCambridge, Marcoux, Brenta, Sanfilippo, Otto and Sigetich fails to teach or suggest the features of the invention as recited in dependent claims 69, 71 and 81.

In view of the above, the Applicants respectfully submit that there is no disclosure or suggestion of the claimed arrangement of elements recited in the claims. Therefore, the cited references fail to support a *prima facie* case of obviousness for purposes of a rejection of claims 1-3, 5, 66-69, 71, 80, 81, 83 and 84 under 35 U.S.C. § 103. Accordingly, claims 1-3, 5, 66-69, 71, 80, 81, 83 and 84 are not rendered obvious in view of the cited references and should be deemed allowable.

The Applicants further submit that new claim 85 is allowable based on the subject matter recited therein and its dependency from independent claim 1.

Conclusion

The Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, the Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application. Moreover, there may be alternative or additional reasons for patentability not discussed in this response.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any

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additional fees that may be due with respect to this paper, may be charged to counsel's deposit
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Respectfully submitted,

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